

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ALBERT E. NAGY

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Appeal No. 95-0044  
Application 07/982,999<sup>1</sup>

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ON BRIEF

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Before KIMLIN, JOHN D. SMITH, and PAK, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed November 30, 1992.

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This is an appeal from the final rejection of claims 1-7, 9, and 10, all the claims remaining in the present application.

Claim 1 is illustrative:

1. A process for electrolytic treatment of copper foil, comprising the steps of:

(A) applying a voltage across an anode and cathode, wherein the anode and cathode are in contact with an electroplating composition containing a gelatin component;

(B) removing organic particulate matter by contacting the electroplating composition containing the organic particulate matter with macroreticular resin; and

(C) electrolytically treating said copper foil.

The examiner relies upon the following references as evidence of obviousness:

Meitzner et al. (Meitzner)	4,486,313	Dec. 4, 1984
Herbert	4,501,646	Feb. 26, 1985
DiFranco et al. (DiFranco)	5,171,417	Dec. 15, 1992

Appellant's claimed invention is directed to a process for

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the electrolytic treatment of copper foil wherein the electroplating composition contains a gelatin component. The process produces a gelatin by-product in the form of an organic particulate which causes defects in laminate boards. Appellant's process removes the organic particulate from the electroplating composition by providing contact between the electroplating composition and a macroreticular resin.

Appealed claims 1-7, 9, and 10 stand rejected under 35 U.S.C. § 112, second paragraph. In addition, the appealed claims stand rejected under 35 U.S.C. § 103 as being unpatentable over Herbert in combination with DiFranco and Meitzner.

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain the examiner's rejections.

We consider first the rejection under § 112, second paragraph. According to the examiner, claim 1 is indefinite because it is not clear where the organic particulate matter is removed from and, also, "where the foil is or how the foil

participates in the overall process during the particulate

removal process." (Page 6 of Answer). However, we fully concur with appellant that when the claim language is read in light of the present specification, as it must be, it is abundantly clear that the organic particulate matter is removed from the electroplating composition. Furthermore, as is evident from the prior art cited in the present specification and applied by the examiner, one of ordinary skill in the art would have no difficulty in understanding how the copper foil is processed in the claimed electrolytic treatment. Regarding the examiner's statement that "[c]laim 1 as written does not specifically state that the gelatin is the organic particulate matter that Appellant is trying to remove from the bath," (page 10 of Answer), it is clear from the present specification that it is not gelatin, but a gelatin by-product, that is the organic particulate matter.

We now turn to the examiner's § 103 rejection. We find no error in the examiner's conclusion that the combined teachings of Herbert and DiFranco evidence that it was known in the art to electrolytically treat copper foil with an electroplating

composition containing a gelatin component. However, as

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maintained by appellant, neither reference teaches that the gelatin produces an organic particulate material as a by-product that must be removed. Also, neither Herbert nor DiFranco teach or suggest contacting the electroplating composition with a macroreticular resin, as required by the appealed claims. While appellant's specification readily acknowledges that Meitzner discloses appellant's macroreticular resin as useful for removal of ionic solutes and organic fluids from fluids, Meitzner provides no suggestion of employing the macroreticular resin in an electrolytic process of the type claimed. Consequently, we agree with appellant that the only motivation for utilizing the macroreticular resin of Meitzner in the processes of Herbert and DiFranco arises from appellant's specification. By now it is axiomatic that the use of such impermissible hindsight cannot support a rejection under 35 U.S.C. § 103.

In conclusion, based on the foregoing, the examiner's

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decision rejecting the appealed claims is reversed.

REVERSED

	)	
Edward C. Kimlin	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
John D. Smith	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
Chung K. Pak	)	
Administrative Patent Judge	)	

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